

REMARKS

Claims 1-2, 4-14, 16-23, 46, 48-56 and 82 are pending in this application; of these Claims 1, 14, 46, 52, and 82 are in independent form.

Please cancel Claim 2 without prejudice. Claims 6 and 7 have been amended to depend from Claim 1. Claims 9, 12, 13, 16, 49-52, 54 and 55 have been amended for clarification purposes.

In the Office Action the Examiner rejected the claims as follows. Claims 1-2, 4-13, 46 and 48-51 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement and as failing to comply with the enablement requirement. Claims 14 and 16-23 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2001/0034630 A1 hereinafter Mayer. Claim 52 was rejected under 35 U.S.C. §102(b) as being anticipated by www.inventors.net which the Examiner states was retrieved from the Internet Archive Wayback Machine of date January 25, 1999 hereinafter InoNet (Office Action dated May 12, 2005, page 7). Claims 1-2, 4-6, 8-13, 46, 48-51, 53-55 and 82 were rejected under 35 U.S.C. §103(a) as being unpatentable over InoNet in view of Mayer. Claims 7 and 56 were rejected under 35 U.S.C. §103(a) as being unpatentable over InoNet in view of U.S. Patent Publication No. 2001/0047276 hereinafter Eisenhart.

As a first initial matter, in a telephonic communication between Applicants' representative Michael J. Musella and Supervising Patent Examiner John G. Weiss on March 31, 2005, it was agreed that the Office Action dated December 17, 2004 would be withdrawn. It is gratefully acknowledged that the Office Action dated December 17, 2004 has been withdrawn.

As a second initial matter, in the section entitled "Response to Amendment" on Page 2 of the present Office Action, the Examiner refers to an amendment filed on October 14, 2004. The amendment referred to by the Examiner was filed on October 12, 2004 and received by the U.S. Patent and Trademark Office on October 14, 2004.

As third initial matter, the present Office Action relies upon InoNet which was allegedly “retrieved from the Internet Archive Wayback Machine for January 25, 1999”, listed in Notice of References Cited and initially referred to on page 7 of the present Office Action. Throughout the document various later dates are listed which do not correspond with the January 25, 1999 date. Accordingly, Applicants respectfully question the dating, publication and validity of the InoNet reference. Applicants also request clarification of the date discrepancy. Applicants further request proof of the publication and publication dates of InoNet.

As a fourth initial matter, Claims 1 and 46 have been amended to delete the objected to “by the first computing device.” Based on at least the foregoing, it is respectfully requested that any new matter rejection based thereon be withdrawn.

As a fifth initial matter, in paragraph 5 of the Response to Amendment section, the Examiner states that “the Invention Proposal server sending a message appears to be new matter,” and that “[t]he application as filed lacks any description of the Invention Proposal server sending a message.” In response, it is respectfully submitted that the Invention Proposal server sending a message” is not new matter and that support for this recitation can be found in the specifications as originally filed (e.g., see Specification, page 55, lines 12-16). Based on at least the foregoing, withdrawal of the objection to claim 14 is respectfully requested.

As a sixth initial matter, in paragraph 6 of the Response to Amendment section of the present Office Action the Examiners asserts that the application as filed lacks any description of “a fee collection system”. Applicants respectfully disagree. Applicants respectfully submit that the specification discloses collecting fees and that “in an Internet embodiment, people could subscribe to one or all of the services by paying a fee” recited at page 12, paragraph beginning on line 10 of the Specification fully supports “a fee collection system”. Further, it is well known in the art that when paying fees using the Internet, a fee collection system would have to be used. Based on at least the foregoing, withdrawal of the objection to Claims 49-51 and 54-55 is respectfully requested.

In response to the rejections of Claims 1-2, 4-13, 46 and 48-51 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement, based on at least the amendments to Claims 1 and 46, and as described above, withdrawal of the rejections is respectfully requested. Accordingly, in light of the discussion above and the amendments to the claims, it is respectfully requested that the Examiner withdraw the §112, first paragraph, rejections of Claims 1-2, 4-13, 46 and 48-51.

In response to the rejections of Claims 1-2, 4-13, 46 and 48-51 under 35 U.S.C. §112, first paragraph, for failing to comply with the enablement requirement, based on at least the amendments to Claims 1 and 46, and as described above, withdrawal of the rejections is respectfully requested. Accordingly, in light of the discussion above and the amendments to the claims, it is respectfully requested that the Examiner withdraw the §112, first paragraph, rejections of Claims 1-2, 4-13, 46 and 48-51.

Regarding the Examiner's rejection of independent Claim 14 under §102(e) as being anticipated by Mayer, amended Claim 14 recites, in part, a security system for determining a confidentiality level for the proposal for invention, and for maintaining records regarding confidentiality levels and authorized access to secured information, the security system including at least one microprocessor. Mayer teaches a method and system for matching candidates to available job positions and further teaches locking identifying data field to prevent employers from receiving candidates identifying data. Mayer fails to teach or suggest all the elements of amended Claim 14. Specifically, Mayer fails to teach or suggest "a security system structured and arranged for determining a confidentiality level for the proposal for invention, for maintaining records regarding confidentiality levels and authorized access to secured information, the security system including at least one microprocessor," as recited in amended Claim 14. At least for the above-noted reasons, Claim 14 is allowable.

The Examiner specifically acknowledges that neither Mayer nor InoNet disclose a record including a confidentiality level or a method wherein the confidentiality level is used to eliminate

a subscriber, on page 15 of the Office Action. Although the Examiner states that this may be obvious, it is respectfully submitted that the Examiner provide proper references to support any obviousness rejections, as required under the law.

Regarding the Examiner's rejection of independent Claim 52 under 35 U.S.C. §102(b) as being anticipated by InoNet, and in addition to the discussion above, it respectfully submitted that the use of the §102(b) citation as applied to the reference in its entirety is improper. As stated above in the third initial matter, the Examiner states that InoNet was "retrieved from the Internet Archive Wayback Machine for January 25, 1999" (Notice of References Cited; and page 7; Office Action, dated May 12, 2004). However, pages 3 to 17 (where the page numbers correspond to the handwritten page numbers) of InoNet, show later dates which are believed to be within one year of the present Application's July 12, 2000 filing date. For at least this reason, it is respectfully submitted that the use of the §102(b) citation, at least in part, is believed to be improper. Moreover, Applicants question the dating, publication and validity of the InoNet. Applicants also request clarification of the date discrepancy. Applicants further request proof of the publication and publication dates of InoNet for each and every page relied on by the Examiner.

Even assuming that InoNet is a valid §102(b) reference in its entirety, the claims of the present application would still be patentable over InoNet. InoNet discloses providing a client, which submitted a problem needing a solution, (which the Examiner equates with the proposal as recited in the claims of the present application—see Office Action, page 9) with a report prepared by InoNet (the company not the reference) see InoNet, pages 5 and 8. Moreover, InoNet teaches using inventors (which the Examiner equates with the inventor and the co-inventors as recited in the claims) for experts and that the names of the experts are not revealed to the client (see InoNet, page 5). In other words a client submits a problem and InoNet prepares a report for the client. InoNet further teaches "the names of the experts are not revealed to the client company, nor is the name of the company revealed to the experts", InoNet page 5. The Examiner incorrectly equates the proposal as used in the claims of the present invention with the problem needing a solution as taught by InoNet. It is respectfully submitted that the problem as taught by

InoNet (Office Action Page 9) is just a problem that states what the existing state of the art does not solve. In contrast, as recited by the claims of the present application, the proposal is not a problem but rather is a solution to a problem.

In contrast, amended Claim 52 includes the recitation “providing by a first computing device a secured forum on a network for a pool of potential co-inventors and an initial inventor to communicate and to further develop a proposal for invention, the proposal for invention being initially submitted by the initial inventor, wherein at least one of said co-inventors in said pool develops at least part of the invention described in the proposal for invention, and wherein information on said forum is displayed according to a level of confidentiality,” which is neither taught nor suggested by InoNet. At least for the above-noted reason, amended Claim 52 is allowable.

Furthermore, the Examiner states that at least part of Claim 52 is anticipated by “Collective Magic” (Office Action, Page 8). It is respectfully requested that the Examiner provide further clarification of this term and state with specificity exactly what is anticipated by “Collective Magic”.

Still further, as previously stated, the Examiner acknowledges that neither Mayer nor InoNet disclose a record including a confidentiality level or a method wherein the confidentiality level is used to eliminate a subscriber as recited in Claim 52. At least for the above-noted reason, amended Claim 52 is allowable.

Regarding the Examiner’s rejection of independent Claims 1, 46 and 82 under §103(a) as being unpatentable over InoNet in view of Mayer, the Examiner states that the combination of InoNet and Mayer discloses each and every element of Claims 1, 46 and 82. Claims 1, 46 and 82 have been amended and contain limitations that are similar to those found in Claims 14 and 52 above. As discussed above, InoNet discloses providing a client that submitted a problem needing a solution with a report prepared by InoNet. Mayer teaches a method and system for matching candidates to available job positions.

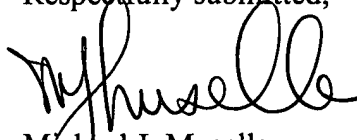
In contrast, amended Claim 1 includes the recitations “determining by the first computing device a confidentiality level for the proposal for invention;” and “providing by the first computing device a forum for the pool of co-inventors and the initial inventor to communicate and to further develop the proposal for invention, wherein at information is provided in the forum according to a level of confidentiality,” amended Claim 46 includes the recitations “determining by the first computing device a confidentiality level for the proposal for invention,” and “creating by the first computing device a proposal for invention database record, said proposal for invention database record including information relating to said confidentiality level;” and amended Claim 82 includes the recitations “code for determining a confidentiality level for the proposal for invention,” and “code that maintains a proposal for invention forum, said proposal for invention forum being accessible to the initial inventor and the pool of co-inventors and said proposal for invention forum allowing the pool of co-inventors to post information to a proposal for invention file, said information being displayed according to a level of confidentiality;” which are neither taught nor suggested by InoNet or Mayer or the combination thereof. Based on at least the foregoing arguments and amendments, withdrawal of the rejections of Claims 1, 46 and 82 is respectfully requested.

Without conceding the patentability per-se of dependent Claims 4-13, 16-23, 48-51² and 53-56, these are likewise believed to be allowable by virtue of their dependence on their respective independent claims.

Should the Examiner believe that a telephone conference or personal interview would

facilitate resolution of any remaining matters, the Examiner may contact Applicants' attorney at the number given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Musella", written over the printed name.

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